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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/733,025
Filing Date: December 09, 2003
Appellant(s): HAZZARD ET AL.

Dan C. Hu
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 14, 2010 appealing from the Office action mailed January 15, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 3-7, 9-13, 15-20 are pending, rejected, and being appealed.

Claims 2, 8, and 14 were previously canceled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

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REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

7,480,723	Grabelsky et al	1-2009
5,815,665	Teper et al	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3-7, 9-13, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teper et al (US. 5,815,665) in view of Grabelsky et al (US 7,480,723).

3. As per claim 1, Teper et al teach a method for providing access to a service, comprising: providing access of a directory of a plurality of services at a portal communicating with a user system (**see at least column 5, lines 49-55, column 8, line 64-column 9, line 24; customized services for individual users**), the plurality of services associated with a plurality of third party vendors, at least some of the plurality of services comprising use of corresponding software applications (**see at least column 1, lines 13-31, column 8, lines 7-19**); receiving a selection of one or more selected services of the identified subset of services from the user system (**see at least column 9, lines 9-53, fig 2; user is presented with customized services and selects a service provided by a service provider**, the one or more selected services associated with one or more conditions governing access to the one or more selected services; receiving a user identifier; linking the one or more selected services with the user identifier; and allowing the user identifier access to the one or more selected services according to the one or more conditions (**see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18**).

Teper et al teach using user specified preferences to customized service to individual users (**see at least column 3, line 65-column 4, line 5**) but fails to *explicitly* teach *receiving, from the user system, a user-specified search value of a search variable directed to a feature of the services; querying, by at least one processor, the directory of the plurality of services according to the search value; and identifying, by at least one processor, a subset of the services of the directory according to the search value*. However, in the same field of endeavor,

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Grabelsky et al teach a method for providing services to a user. The method allows the user to enter a query into the user device. The query is then used to search a database to find matches. A response with a portion of the list of matches found is sent to the user (**see at least figs 7-9, column 1, line 57-column 2, line 3**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Teper et al and Grabelsky et al because doing so would allow the system in Teper to use a search value provided by the user as a way to customized the services for the requesting user.

Furthermore, Teper et al and Graberlsky et al fail to explicitly teach the user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services. However, it would have been obvious to one of ordinary skill in the art to modify Teper et al and Graberlsky et al to include this feature because doing so would allow the system to identify a subset of the directory based on the software application desired. The modification would require merely modifying the data in the database to associate an additional search value that indicates a software application of that service(s). The subset of the directory that is identified according to the search value obtained from the user remains unchanged regardless of the search value used.

It is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention. Thus the claimed subject matter likely would have been obvious under **KSR**.

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4. As per claim 3, Teper et al- Graberlsky teach providing a list of a plurality of categories of the plurality of services; receiving a selected category of the plurality of categories from the user system, and wherein identifying the subset is further based on the selected category (**see at least column 5, lines 49-55, column 8, line 64-column 9, line 24, also in Graberlsky see column 14, lines 29-31**).

5. As per claim 4, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises: verifying a passcode corresponding to the user identifier; and providing the user identifier access to the one or more selected services in response to verifying the passcode, the one or more selected services comprising at least one service furnished by at least one third party vendor (**see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18**).

6. As per claim 5, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises: determining usage of access to the one or more selected services; calculating compensation for the usage according to the one or more conditions; and providing the compensation to at least one third party vendor furnishing the one or more selected services (**see at least column 1, lines 37-41, column 8, lines 20-25**).

7. As per claim 6, Teper et al teach wherein allowing the user identifier access to the one or more selected services according to the one or more conditions further comprises allowing the user identifier access to the one or more selected services through the portal (**see at least column 9, lines 50-60, column 15, line 57-column 16, lines 18**).

8. As per claims 7, 9-13, and 15-20, these claims contain similar limitations as claims 1 and 3-6 above and therefore are rejected for similar reasons.

(10) Response to Argument

Argument A: the Appellant argues that the combination would not have been obvious and is based on inexpressible hindsight.

In response, the Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Teper et al teach using user specified preferences to customized service to individual users (**see at least column 3, line 65-column 4, line 5**) but fails to *explicitly teach receiving, from the user system, a user-specified search value of a search variable directed to a feature of the services; querying the directory of the plurality of services according to the search value; and identifying the subset of the directory according to the search value*. However, in the same field of endeavor, Grabelsky et al teach a method for providing services to a user. The method allows the user to enter a query into the user device. The query is then used to search a database to find matches. A response with a portion of the list of matches found is sent to the user (**see at least figs 7-9, column 1, line 57-column 2, line 3**). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Teper et al and

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Grabelsky et al because doing so would allow the system in Teper to use a search value provided by the user as a way to customized the services for the requesting user. Furthermore, Teper et al and Graberlsky et al fail to explicitly teach the user-specified search value of a search variable directed to a feature indicating a type of software application of at least one service of the services. However, it would have been obvious to one of ordinary skill in the art to modify Teper et al and Graberlsky et al to include this feature because doing so would allow the system to identify a subset of the directory based on the software application desired. The modification would require merely modifying the data in the database to associate an additional search value that indicates a software application of that service(s). The subset of the directory that is identified according to the search value obtained from the user remains unchanged regardless of the search value used.

It is noted that **KSR** forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under **KSR**, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than **predictable results** to one of ordinary skill in the art at the time of the invention. Thus the claimed subject matter likely would have been obvious under **KSR**.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Argument B: *With respect to dependent claim 3, the asserted combination of Teper and Grabelsky fails to disclose or hint at providing a list of a plurality of categories of the plurality of services, receiving a selected category of the plurality of categories from the user system, and identifying the subset of the directory according to the search value and to the selected category.*

In response, the Examiner respectfully disagrees. Teper and Grabelsky teach the claimed limitation. Teper teach a service customization feature in which user specified information such as the user's system configuration or display preferences (categories to search) is used to provide services (subset based on the searched category) that are customized for that individual user. See at least column 5, lines 49-55, column 8, line 64-column 9, line 24. Grabelsky also teaches that a search category with several sub-categories is returned to the user (see Grabelsky at column 14, lines 29-31).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ramsey Refai/

Primary Examiner, Art Unit 3627

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Vincent Millin/vm/
Appeals Conference Specialist

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